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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,451	09/19/2003	Anthony D. Prescott	EAG-023	8367
36822	7590	12/08/2004	EXAMINER	
GORDON & JACOBSON, P.C. 65 WOODS END ROAD STAMFORD, CT 06905			ISABELLA, DAVID J	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/666,451	Applicant(s) PRESCOTT ET AL.	
	Examiner DAVID J ISABELLA	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-18 and 27-49 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 29 and 31-39 is/are allowed.  
 6) ☒ Claim(s) 1,3-18,27,28 and 40-49 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of the Claims***

Claims 2,19-26,30 have been cancelled. Claims 40-49 have been newly added.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-7,28,48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shea, et al (4292693) in view of Antonelli, et al (6726719).

Shea et al discloses a stapedial prosthesis sized to be implanted as a replacement for the stapes between the incus and the oval window of the middle ear, comprising: a body defining a bucket sized to at least partially receive a portion of the incus, and a shaft having a length sufficient to extend from the incus to the oval window; and b) a handle coupled to said bucket. While Shea et al, an older patent, utilizes stainless steel, the art teaches that titanium and stainless steel are well known for their spring-like properties and their use as a spring in the otic art is well documented, see Antonelli, et al.. To fabricate the wire handle of Shea et al out of titanium for its superior spring-like properties as a spring-like element for capturing the incus would have been an obvious substitution of equivalent elements as taught by Antonelli, et al.

Claim 3, if not inherent, the use of biocompatible commercial grade 4 Ti would have been obvious to one with ordinary skill in the art as one of the many choices from the approved materials listed in the ASTM handbook.

Claim 4, as worded does not appear to distinguish over the conformation of the bucket and U-shaped handle of Shea, et al. Certainly, the handle has two ends and once inserted into the bucket, the handle is subjected to load.

Claim 5, the holes of Shea et al are configured diametrically opposite on the bucket.

Claims 6 and 7, see notch 26 in the rim which terminates above the holes of the bucket of Shea et al.

Claim 9, as broadly worded the handle of Shea, et al is rotatably coupled to the bucket.

Claims 10 and 12, see rejection to claim 4 supra.

Claim 11, see prosthesis of Antonelli, et al.

Claim 13, the structure of Shea et al as modified would inherently yield a spring loaded handle as broadly claimed.

Claim 27 see stapedial prosthesis of Shea et al.

Claim 28, the language of the claim does not preclude the intermediate product where the first and second ends are not coupled.

Claim 29, the method for attaching the stapedial prosthesis of Shea, et al would inherently meet the steps as outlined by applicant.

Claims 48 and 49, see rejection to claim 1 supra.

Claims 8,11,12,14 and 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shea et al (4292693) in view of Antonelli, et al (6726719) as applied to claim 1 above, and further in view of Muller (6540661).

Muller teaches a bucket type capturing mechanism comprising slots formed therein. While the bucket of Muller is not intended for capturing the incus, the principle of providing slots in a wall member to increase wall flexibility is well known in any art. To provide slots in the bucket of Shea et al to increase the wall flexibility so as to offer the surgeon a more effective capturing of the incus would have been obvious to one with ordinary skill in the art from the teachings of Muller.

Claims 11 and 12, see body composition of the slotted bucket of Muller.

Claim 14, the slots in the bucket of Shea et al would offer the function of adjusting the diameter of the bucket by manipulation of the wall segments and the segments would retain the adjusted diameter if the applied force exceeds the modulus of the material.

Claims 15-17, while Muller is silent as to the dimension of the slot, it appears that in comparing the two devices, applicant's and Muller, the slot would approximately fall within the range as claimed.

Claim 18, the bottom of the bucket of Shea et al is closed.

Claim 40, the slots in the bucket of Shea et al would offer the function of adjusting the diameter of the bucket by manipulation of the wall segments and the

Art Unit: 3738

segments would retain the adjusted diameter if the applied force exceeds the modulus of the material.

Claims 41-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shea et al (4292693) in view of Antonelli, et al (6726719) and of Muller (6540661) as applied to claim 14 above, and further in view Prescott (554188).

Prescott illustrates a stapedial prosthesis with a stepped stem similar to that as claimed. Based on the desired pre surgical responsive properties, one with ordinary skill in the art would make a stepped stem structure to provide the predetermined vibratory and function responses of the acoustical chain.

#### ***Allowable Subject Matter***

Claims 29-39 are allowed.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP


§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J ISABELLA  
Primary Examiner  
Art Unit 3738

DJI  
JUNE 15, 2004